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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/685,750

10/15/2003

Mark Budzik

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32116

7590

05/05/2005

WOOD, PHILLIPS, KATZ, CLARK & MORTIMER
500 W. MADISON STREET
SUITE 3800
CHICAGO, IL 60661

EXAMINER

SPAHN, GAY

ART UNIT

PAPER NUMBER

3673

DATE MAILED: 05/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/685,750

Applicant(s)

BUDZIK, MARK

Examiner

Gay Ann Spahn

Art Unit

3673

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) 11-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-32 are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 October 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 15 October 2003.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions - Restriction Requirement

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-12, drawn to a drywall-trimming accessory, classified in class 52, subclass 255.
- II. Claims 13-32, drawn to a method of making a drywall-trimming accessory, classified in class 451, subclass 28.

Inventions II and I are related as process of making and product made, respectively. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product of the drywall-trimming accessory as claimed can be made by another and materially different process such as one in which the drywall-trimming accessory does not have to have the superficial layer removed by "milling" in order to expose the open cells of the cellular polymer material from which the drywall-trimming accessory is made (e.g., formed with outer surface exposing open cells).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Election/Restrictions – Election of Species Requirement

This application contains claims directed to the following patentably distinct species of the claimed invention: Figures 1-2; Figure 3; and Figure 4.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, independent claims 1, 3, 5, 7, 13, 15, 17, 19, 21, 23, 25, and 27 appear to be generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over

the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

During a telephone conversation with Attorney Allen J. Hoover on March 16, 2005 a provisional election was made with traverse to prosecute the invention of Group I and the species of Figures 1-2 (i.e., claims 1-10). Affirmation of this election must be made by applicant in replying to this Office action. Claims 13-32 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention and claims 11 and 12 are withdrawn from consideration (until such time as a generic claim is found to be allowable) as being drawn to a non-elected species.

Information Disclosure Statement

The information disclosure statement (IDS) submitted on October 15, 2003 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement has been considered by the examiner.

However, reference A9 (i.e., D432,304) on the Information Disclosure Statement By Applicant (PTO-Form-1449) appears to be an incorrect number when checked against the references discussed in the Background of the Invention section of the specification. Therefore, the examiner has changed D432,304 on the Information Disclosure Statement By Applicant to D412,673, since it is believed that this design patent number from page 1, line 24, of the specification was what was intended for the examiner to consider.

Drawings

Figures 1 and 2 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

The abstract of the disclosure is objected to because it appears to be missing the word --styrene-- and a period punctuation mark after the words "acrylonitrile-butadiene-" in the last sentence. Correction is required. See MPEP § 608.01(b).

The disclosure is objected to because of the following informalities: (1) in the Brief Description of the Drawings section beginning on page 4, line 15, Figures 1 and 2 should be noted to be prior art figures; (2) on page 8, line 5, there should be a space between the word "portion" and the reference numeral "212"; and (3) on page 8, line 5, reference numeral "214" is discussed, but it is not shown in the drawing figures.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koenig, Jr. et al. (U.S. Patent Application Publication No. 2002/0134035 A1 published on September 26, 2002) in view of Hawley's Condensed Chemical Dictionary and Hoffmann, Sr. (U.S. Patent No. 6,684,586).

Koenig, Jr. et al. disclose a drywall-trimming accessory (strip 10) having a flange (30), which has two expansive surfaces (32, 24) facing oppositely, wherein the drywall-trimming accessory (strip 10) is made from a cellular polymer (see lines 1-2 of abstract - "extruded from a polymeric material, such as polyvinyl chloride").

The examiner notes that Hawley's Condensed Chemical Dictionary (Eleventh Edition, revised by N. Irving Sax and Richard J. Lewis, Sr., published by Van Nostrand Reinhold Company, Inc., New York, © 1987) defines "foams, plastic" (page 534) as follows:

A cellular plastic which may be either flexible or rigid. Flexible foams may be polyurethane, rubber latex, polyethylene or vinyl polymers, rigid foams are chiefly polystyrene, polyurethane, epoxy, and **polyvinyl chloride**. . . .
(Emphasis added).

Thus, Koenig, Jr. et al.'s disclosure of his drywall-trimming accessory (strip 10) being made of polymeric material such as polyvinyl chloride is considered to meet the claim recitation of a cellular polymer. However, it certainly would have been obvious to form the polyvinyl chloride (PVC) trimming strip (10) of Koenig, Jr. et al. from a cellular, or open cell, polyvinyl chloride (PVC), since such is a well known and highly utilized polyvinyl chloride (PVC) as expressed by Hawley's Condensed Chemical Dictionary.

Koenig, Jr. et al. fail to disclose claim 1's limitation that at least part of at least one of the expansive surfaces of the flange is characterized by open cells of the cellular polymer.

Hoffmann, Sr. discloses a strip of polymer material that is used as a corner bead or drywall tape (abstract, lines 1-2). Further, at col. 2, lines 19-22, Hoffmann, Sr. discloses that "the strip is perforated and knurled to increase the surface area and to facilitate the ability of construction adhesives and drywall compound to adhere to the surface of the strip."

As to claim 2, Hoffmann, Sr. also discloses that the same part of the same one of the expansive surfaces of the flange is contacted by a drywall-finishing compound, which penetrates said cells (i.e., the roughened surface is exposed to drywall compound and the drywall compound is readily absorbed by the roughened surface).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the drywall-trimming accessory (strip 10) of Koenig, Jr. et al. by milling, abrading or otherwise roughening at least a part of at least one of the expansive surfaces of the flanges thereof and contacting the same part of the same one

of the expansive surfaces of the flange thereof to a drywall-finishing compound as taught by Hoffmann, Sr. in order to increase the surface area and thus expose the open cells of the cellular polymer to the drywall compound so that the drywall trimming accessory would be better able to absorb the drywall compound.

As to claim 3, Koenig, Jr. et al. disclose a drywall-trimming accessory (strip 10) having a flange (30), which has two expansive surfaces (32, 24) facing oppositely, wherein the drywall-trimming accessory is made from a cellular polymer.

As stated above with respect to the rejection of claim 1, the examiner considers that Koenig, Jr. et al.'s disclosure of his drywall-trimming accessory (strip 10) being made of polymeric material such as polyvinyl chloride meets the claim recitation of a cellular polymer based on the definition of "plastic foams" from Hawley's Condensed Chemical Dictionary. However, it certainly would have been obvious to form the polyvinyl chloride (PVC) trimming strip (10) of Koenig, Jr. et al. from a cellular, or open cell, polyvinyl chloride (PVC), since such is a well known and highly utilized polyvinyl chloride (PVC) as expressed by Hawley's Condensed Chemical Dictionary.

Koenig, Jr. et al. fail to disclose claim 3's limitation that at least part of each expansive surface of the flange is characterized by open cells of the cellular polymer.

Hoffmann, Sr. discloses a strip of polymer material that is used as a corner bead or drywall tape (abstract, lines 1-2). Further, at col. 2, lines 19-22, Hoffmann, Sr. discloses that "the strip is perforated and knurled to increase the surface area and to facilitate the ability of construction adhesives and drywall compound to adhere to the surface of the strip."

As to claim 4, Hoffmann, Sr. also discloses that the same part of each expansive surface of the flange is contacted by a drywall-finishing compound, which penetrates said cells (i.e., the roughened surface is exposed to drywall compound and the drywall compound is readily absorbed by the roughened surface).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the drywall-trimming accessory (strip 10) of Koenig, Jr. et al. by milling, abrading or otherwise roughening at least part of each expansive surface of the flange thereof and contacting the same part of each expansive surface of the flange thereof with drywall compound as taught by Hoffmann, Sr. in order to increase the surface area and thus expose the open cells of the cellular polymer so that the drywall trimming accessory would be better able to absorb the drywall compound.

As to claim 5, Koenig, Jr. et al. disclose a drywall-trimming accessory (strip 10) having two diverging flanges (30, 30), each of which has two expansive surfaces (32, 24) facing oppositely, wherein the drywall-trimming accessory (strip 10) is made from a cellular polymer.

As stated above with respect to the rejection of claim 1, the examiner considers that Koenig, Jr. et al.'s disclosure of his drywall-trimming accessory (strip 10) being made of polymeric material such as polyvinyl chloride meets the claim recitation of a cellular polymer based on the definition of "plastic foams" from Hawley's Condensed Chemical Dictionary. However, it certainly would have been obvious to form the polyvinyl chloride (PVC) trimming strip (10) of Koenig, Jr. et al. from a cellular, or open

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cell, polyvinyl chloride (PVC), since such is a well known and highly utilized polyvinyl chloride (PVC) as expressed by Hawley's Condensed Chemical Dictionary.

Koenig, Jr. et al. fail to disclose claim 5's limitation that at least part of at least one of the expansive surfaces of each flange is characterized by open cells of the cellular polymer.

Hoffmann, Sr. discloses a strip of polymer material that is used as a corner bead or drywall tape (abstract, lines 1-2). Further, at col. 2, lines 19-22, Hoffmann, Sr. discloses that "the strip is perforated and knurled to increase the surface area and to facilitate the ability of construction adhesives and drywall compound to adhere to the surface of the strip."

As to claim 6, Hoffmann, Sr. also discloses that the same part of the same one of the expansive surfaces of each flange is contacted by a drywall-finishing compound, which penetrates said cells (i.e., the roughened surface is exposed to drywall compound and the drywall compound is readily absorbed by the roughened surface).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the drywall-trimming accessory (strip 10) of Koenig, Jr. et al. by milling, abrading or otherwise roughening at least part of at least one of the expansive surfaces of each flange thereof and contacting the same part of the same one of the expansive surfaces of each flange thereof with drywall compound as taught by Hoffmann, Sr. in order to increase the surface area and thus expose the open cells of the cellular polymer so that the drywall trimming accessory would be better able to absorb the drywall compound.

As to claim 7, Koenig, Jr. et al. disclose a drywall-trimming accessory (strip 10) having two diverging flanges (30, 30), each of which has two expansive surfaces (32, 24) facing oppositely, wherein the drywall-trimming accessory (strip 10) is made from a cellular polymer.

As stated above with respect to the rejection of claim 1, the examiner considers that Koenig, Jr. et al.'s disclosure of his drywall-trimming accessory (strip 10) being made of polymeric material such as polyvinyl chloride meets the claim recitation of a cellular polymer based on the definition of "plastic foams" from Hawley's Condensed Chemical Dictionary. However, it certainly would have been obvious to form the polyvinyl chloride (PVC) trimming strip (10) of Koenig, Jr. et al. from a cellular, or open cell, polyvinyl chloride (PVC), since such is a well known and highly utilized polyvinyl chloride (PVC) as expressed by Hawley's Condensed Chemical Dictionary.

Koenig, Jr. et al. fail to disclose claim 7's limitation that at least part of each expansive surface of each flange is characterized by open cells of the cellular polymer.

Hoffmann, Sr. discloses a strip of polymer material that is used as a corner bead or drywall tape (abstract, lines 1-2). Further, at col. 2, lines 19-22, Hoffmann, Sr. discloses that "the strip is perforated and knurled to increase the surface area and to facilitate the ability of construction adhesives and drywall compound to adhere to the surface of the strip."

As to claim 8, Hoffmann, Sr. discloses that the same part of each expansive surface of each flange is contacted by a drywall-finishing compound, which penetrates

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said cells (i.e., the roughened surface is exposed to drywall compound and the drywall compound is readily absorbed by the roughened surface).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the drywall-trimming accessory (strip 10) of Koenig, Jr. et al. by milling, abrading or otherwise roughening at least part of each expansive surface of each flange thereof and contacting the same part of each expansive surface of each flange thereof with drywall compound as taught by Hoffmann, Sr. in order to increase the surface area and thus expose the open cells of the cellular polymer so that the drywall trimming accessory would be better able to absorb the drywall compound.

As to claim 9, Koenig, Jr. et al. disclose that the drywall-trimming accessory is an elongate strip.

As to claim 10, Koenig, Jr. et al. disclose that the polymeric material is polyvinyl chloride.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Patent Application Publication No. 2004/0163340 to Harel discloses a drywall bead with knurled paper flaps and method of making same. U.S. Patent Application Publication No. 2003/0213196 to Harel discloses a drywall finishing trim having fiber covering fabricated with strengthening compound. U.S. Patent Application Publication No. 2003/0056453 to Young discloses a drywall inside plastic corner device. U.S. Patent Application Publication No. 2002/0035809 to Smythe, Jr.

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discloses a boxable drywall corner bead. U.S. Patent No. 6,363,673 to Robertson discloses a drywall trim piece. U.S. Patent Application Publication No. 2001/0039775 to Smythe, Jr. discloses a drywall finishing outside corner end-cap. U.S. Patent No. 5,459,969 to Stibolt et al. discloses a drywall corner finishing device.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gay Ann Spahn whose telephone number is (571)-272-7731. The examiner can normally be reached on Monday through Thursday, 8:30 am to 7:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather C. Shackelford be reached on (571)-272-7049. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



HEATHER SHACKELFORD
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

Gay Ann Spahn, Patent Examiner
May 2, 2005